

REMARKS

Claim Rejections Under 35 U.S.C. § 103

Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74, 79-81 are pending in the present application, with Claims 1 and 63 being independent. In the Office Action, the examiner rejected Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74, 79-81 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,221,838 (hereinafter Gutman et al.) in view of one or more of U.S. Patent No. 5,748,737 (hereinafter Daggar) and U.S. Patent No. 5,563,393 (hereinafter Coutts). Applicant respectfully traverses that rejection and requests reconsideration.

Independent Claims

The proposed modification of Gutman in view of Daggar and Coutts, either alone or in combination, lacks one or more limitations recited in each of independent claims 1 and 63 in at least the following respects.

- As acknowledged by the examiner, Gutman fails to teach or suggest a method of contactless interfacing for a financial transaction smart card, in which a user is allowed to establish a physical contact bi-directional communication interface between the financial transaction smart card and a hand-held computing device for accessing a financial transaction smart card application on a microcomputer of the financial transaction smart card, as recited in claims 1 and 63. Yet the examiner asserts that the financial card of Gutman provides bi-directional communication. With respect, the examiner has failed to grasp the difference between a magnetic-stripe card and a financial transaction smart card. A magnetic-stripe card is incapable of communication. Rather, it stores information. Other devices may read and write information to the magnetic-stripe card, but the magnetic-stripe card takes no active role in communicating the information. In other words, the magnetic-stripe card never engages with any other device except as a passive participant. By contrast, a financial transaction smart card actively participates in communication with other devices, including a

terminal at a financial institution. Whereas a magnetic-stripe card only stores information, a financial transaction smart card stores *and actively transmits* information.

- Nor does Gutman teach or suggest a method of contactless interfacing for a financial transaction smart card in which the user is allowed to initiate a contactless bi-directional communication interface via the hand-held computing device as a conduit between the financial transaction smart card application on the microcomputer of the financial transaction smart card and a self-service transaction terminal of an on-line system of a financial institution, as recited in amended claims 1 and 63. A financial transaction smart card is capable of bi-directional communication, using a hand-held computing device as a conduit. In other words, the hand-held computing device opens a channel and allows the financial transaction smart card itself to communicate information through the channel. Gutman, however, discloses a hand-held computing device that does not act as a conduit—instead, the hand-held computing device of Gutman first must gather information from the passive magnetic-stripe card. At that point, the hand-held computing device of Gutman communicates information. At no point does the magnetic-stripe card itself engage in any communication.
- Daggar fails to remedy the deficiencies of Gutman. Daggar does not teach a method of contactless interfacing for a financial transaction smart card in which the user is allowed to initiate a contactless bi-directional communication interface via the hand-held computing device as a conduit between the financial transaction smart card application on the microcomputer of the financial transaction smart card and a self-service transaction terminal of an on-line system of a financial institution, as recited in claims 1 and 63. Instead, Daggar teaches downloading and storing smart card applications to the hand-held computing device and thereafter choosing one of the downloaded applications (referred to by Daggar as “digital cards”) on the hand-held device to perform a transaction using only the hand-held device and eliminating any need for a smart card, and/or in turn further downloading the “digital cards” stored on the hand-held device to a “generic

multimedia card,” which can then be carried around and used without the hand-held device. (See, e.g., Daggar, Col. 12, ll. 1-8; Col. 13, ll. 13-27; and Col. 18, ll. 45-51). Accordingly, the hand-held device of Daggar merely downloads the smart card applications, and the smart card does not communicate bi-directionally with a terminal of a financial institution. Moreover, because the hand-held computing device in Daggar merely reads and writes to smart cards, Daggar clearly does not disclose the use of a hand-held computing device as a conduit through which a financial transaction smart card engages in bi-directional communication.

- Likewise, Coutts fails to remedy the deficiencies of Gutman and Daggar. Instead of a method of contactless interfacing for a financial transaction smart card in which the user is allowed to initiate a contactless bi-directional communication interface via the hand-held computing device as a conduit between the financial transaction smart card application on the microcomputer of the financial transaction smart card and a self-service transaction terminal of an on-line system of a financial institution, as recited in claims 1 and 63, Coutts teaches a hand-held device (i.e., a notepad personal computer) that has a RF modem (i.e., a PC card, formerly known as a PCMCIA card) by which the hand-held device communicates directly with a terminal (i.e., an ATM) to diagnose technical problems. (See, e.g., Coutts, Col. 2, l. 21-Col. 3, l. 13). Respectfully, the examiner appears to misunderstand the difference between a financial transaction smart card and a PCMCIA card. As Coutts explains, a PCMCIA card is simply “an integrated circuit card, configured to operate as a modem.” (see Coutts, Col. 2, ll. 58-61). A PCMCIA card does not have any ability to store financial information or financial transaction smart card applications. By contrast, a financial transaction smart card can, for example, contain a microcomputer with memory to set up and securely store data. (See Specification, p. 5, ll. 5-7.) The examiner argues that it would have been obvious to modify by substituting the PCMCIA card. As the foregoing remarks show, however, a PCMCIA card bears no relation to a financial transaction smart card and performs wholly different

functions. Accordingly, the combination of a PCMCIA card with Gutman would *not* have the effect of allowing contactless bi-directional communication between a financial transaction smart card and a terminal of a financial institution.

- Finally, the examiner faulted Applicant for “attacking references individually.” With respect, Applicant has demonstrated Gutman’s deficiencies (with which examiner has agreed). Moreover, Applicant has demonstrated that neither Daggar nor Coutts (nor the combination of Daggar and Coutts) remedies Gutman’s deficiencies. Accordingly, Applicant has not merely attacked references individually; rather, Applicant has shown that the cited references, separately or in combination, do not recite the limitations present in independent claims 1 and 63.

Consequently, Gutman and/or Daggar and/or Coutts, separately or in combination with one another, do not recite the required combination of limitations of independent claims 1 and 63. Because the cited references, either alone or in combination, do not teach the limitations of independent claims 1 and 63, the examiner has failed to establish the required *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (CCPA 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); see also MPEP § 2143.03.

Summary

Thus, Applicant submits that independent Claims 1-5, 8, 10-17, 22, 27, 33, 39, 42-50, 55-58, 63-66, 69-74, 79-81 are patentable over the documents cited by the examiner. Additionally, the remaining claims depend from one of the independent claims either directly or indirectly and are submitted to be patentable for similar reasons. The dependent claims also recite additional features further defining the present invention over the cited documents, and Applicant submits that the cited documents do not teach or suggest integrating those features into the presently claimed invention. Accordingly, Applicant requests separate and individual consideration of each dependent claim.

Applicant has not addressed each specific rejection of the independent and dependent claims because Applicant submits that the independent claims are allowable over the documents of record, as discussed above. Applicant has not acquiesced to any such rejection and reserves the right to address the patentability of any additional claim features in the future.

CONCLUSION

Applicant submits the foregoing as a full and complete response to the Official Action dated October 31, 2007. Applicant submits that this Response places the application in condition for allowance and respectfully requests such action. Applicant submits that the amendments made herein and the remarks provided above do not present any new issues for review by the examiner. If any issues exist that can be resolved with an examiner's Amendment or a telephone conference, please contact Applicant's undersigned attorney at the number listed below.

Respectfully submitted,

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